



#8 10-14-94
Amelt-C

PATENT
Attorney Docket No. 2473.0001-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Paul YURT et al.

Serial No.: 08/133,982

Group Art Unit: 2603

Filed: October 8, 1993

Examiner: A. Le

For: AUDIO AND VIDEO TRANSMISSION
AND RECEIVING SYSTEM

Honorable Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Sir:

AMENDMENT

This is a response to the Office Action mailed on
August 9, 1994, the period for response to which extends
through November 9, 1994.

Please amend the application as follows:

IN THE SPECIFICATION:

Page 12, line 8, after "recorder." insert The receiving
system recognizes copy protected programs and disables the
audio/video recorder.

IN THE CLAIMS:

Claim 39, line 2, delete "central".

LAW OFFICES
FINNEGAN, HENDERSON
FARABOW, GARRETT
& DUNNER
1300 I STREET, N.W.
WASHINGTON, DC 20005
1-202-408-4000

REMARKS

In the Office Action, the Examiner rejected claims 21, 22, and 40 under 35 U.S.C. § 101 in view of U.S. Patent No. 5,132,992 ("the '992 patent") and rejected claims 23 through 39 and 42 through 49 under the judicially created doctrine of obviousness-type double patenting in view of the '992 patent. The Examiner also objected to the specification and rejected claim 39 under 35 U.S.C. § 112, second paragraph.

In response to the Examiner's objection to the specification, Applicants have amended the specification. Applicants respectfully submit that the amendment fully responds to the Examiner's objections.

In response to the Examiner's rejection of claim 39 under 35 U.S.C. § 112, second paragraph, Applicants have amended claim 39. Applicants respectfully submit that the amendment to claim 39 fully responds to the Examiner's rejection and places claim 39 in conformance with 35 U.S.C. § 112, second paragraph.

In response to the Examiner's rejection for obviousness-type double patenting in view of the '992 patent, Applicants are filing a Terminal Disclaimer with this amendment. Applicants respectfully submit that the Terminal Disclaimer fully responds to the Examiner's rejection. While Applicants do not subscribe to the Examiner's observation regarding obviousness, the Terminal Disclaimer is being filed in order to advance the prosecution of this application as quickly as possible.

The Examiner's rejection of claims 21-22 under 35 U.S.C. § 101 is improper. A rejection under 35 U.S.C. § 101 for double patenting only applies to a claimed invention drawn to identical subject matter in an issued patent. In re Longi, 759 F.2d 887, 892 (Fed. Cir. 1985).

Claims 21 and 22 of the application cover different subject matter than claim 1 of the '992 patent. For example, as the Examiner recognizes, claims 21 and 22 do not recite ordering means and compression means as claim 1 does. Thus, a system may infringe claims 21 and 22 without infringing claim 1 of the '992 patent, and the claims must be drawn to different inventions. Additionally, claim 21 recites coordinated transmission of the formatted data which is not recited in claim 1 of the '992 patent, and claim 22 recites a plurality of geographically separated libraries which are not recited in claim 1 of the '992 patent. Therefore, claims 21 and 22 do not recite the same invention as claim 1 of the '992 patent, and Applicants request withdrawal of the 35 U.S.C. § 101 rejection.

The Examiner's rejection of claim 40 under 35 U.S.C. § 101 is also improper. Claim 40 covers different subject matter than claim 25 of the '992 patent. For example, as the Examiner recognizes, method claim 40 of the present application does not recite data decompressing, while apparatus claim 25 of the '992 patent recites data decompressing means. Claim 25 of the '992 patent does not recite transmitting a representation of at least one item at a real time rate to at least one of a plurality of subscriber receiving stations, as claim 40 does.

Additionally, an identical invention double patenting rejection should not apply between a method claim, which is not limited to a specific apparatus, and an apparatus claim, which is not limited to practicing a specific method.

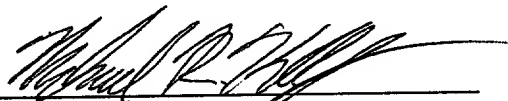
Therefore, claim 40 of the present application is drawn to a different invention than claim 25 of the '992 patent, and Applicants request the Examiner remove the rejection under 35 U.S.C. § 101.

Claims 21-49 are therefore in condition for allowance, and Applicants request reconsideration of the application, and allowance of the pending claims.

If there are any fees due in connection with the filing of this amendment, please charge the fees to our Deposit Account No. 06-0916. If an extension of time under 37 C.F.R. 1.136 not accounted for above is required for the entry of this amendment, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER

By: 
Michael R. Kelly
Registration No. 33,921

Dated: September 21, 1994

assignee's knowledge and belief, title to the above-identified application and the United States Patent No. 5,132,992 are in assignee, which is submitting this Terminal Disclaimer.

To obviate a double patenting rejection, Petitioner hereby disclaims, under the provisions of 37 C.F.R. § 1.321, the terminal part of any patent granted on the above-identified application, Serial No. 08/133,982, which would extend beyond the expiration date of Patent No. 5,132,992 and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. 5,132,992, this agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successors or assigns.

Petitioner does not disclaim the terminal part of any patent granted on the above-identified application Serial No. 08/133,982 which would extend beyond the expiration date of the full statutory term, as presently shortened by any terminal disclaimer, of United States patent 5,132,992 in the event such patent expires for failure to pay a maintenance fee, is held unenforceable, is found invalid, is statutorily disclaimed in whole under 35 U.S.C. § 253 and 37 C.F.R. § 1.321(a), has all claims cancelled by a reexamination certificate, or is otherwise terminated prior to the expiration of its full statutory term, as presently shortened by any terminal disclaimer, except for separation of legal title as stated above.

In accordance with the fee schedule set forth in 37 C.F.R. § 1.20(d), the required fee of \$110.00 is being filed with this disclaimer.

If a check for the required fee is not filed concurrently herewith or if there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 06-0916. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

The undersigned is authorized to act on behalf of assignee H. Lee Browne. I hereby declare that all statements made of my own knowledge and belief are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER

By: 

E. Robert Yoches
Registration No. 30,120

Dated: September 21, 1994